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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,401	03/26/1999	MICHAEL JAYE	22,944-C USA	3515

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EXAMINER

KERR, KATHLEEN M

ART UNIT	PAPER NUMBER
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1652

24

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,401

Applicant(s)

JAYE ET AL.

Examiner

Kathleen M Kerr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15, 16, 22, 44, 57-59, 62, 63 and 98-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15, 16, 22, 44, 57-59, 62, 63 and 98-105 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Application Status

1. Claims 15, 16, 22, 44, 57-59, 63-65, and 98-105 are pending by virtue of an amendment filed June 12, 2003 along with a request for a Continued Prosecution Application (CPA). All previously examined claims have been cancelled; the pending CPA is a divisional CPA. More than one invention is found in the pending claims. Thus, the following Restriction is asserted as based on the previous restriction of record (see Paper No. 7 mailed April 24, 2001).

Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I (Previous Group VI).

Claims 15, 16, 98 and 99, drawn to compositions containing ribozymes that cleave mRNA encoding LIPG, DNA encoding said ribozymes, classified in class 536, subclass 24.5.

II (Previous Group XIII).

Claim 22, drawn to compositions containing enhancers of LIPG activity, classified in class 530, subclass 350.

III (Previous Groups XIV and XVIII).

Claims 44 and 100-102, drawn to methods of raising HDL cholesterol and apolipoprotein AI by administering a composition that lowers LIPG enzymatic activity (ribozyme) and a composition capable of expression apolipoprotein AI, classified in class 514, subclass 44.

IV (Previous Group XXIV).

Claim 57, drawn to methods of lowering LDL cholesterol by administering an enhancer of LIPG-LDL that is preferential over LIPG-HDL, classified in class 514, subclass 2.

V (Previous Group XXV).

Claim 58, drawn to methods of lowering VLDL cholesterol by administering an enhancer of LIPG-VLDL that is preferential over LIPG-HDL, classified in class 514, subclass 2.

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VI (Previous Group XXVI).

Claims 59 and 103-105, drawn to methods for diagnosing a predisposition to low HDL and apolipoprotein AI levels by measuring LIPG levels in a tissue sample, classified in class 435, subclass 19.

VII (Previous Group XXVII).

Claim 63, drawn to methods for determining inhibitors of LIPG-HDL-apolipoprotein AI, classified in class 435, subclass 4.

VIII (Previous Group XXVIII).

Claim 64, drawn to methods for determining enhancers of LIPG-VLDL, classified in class 435, subclass 4.

IX (Previous Group XXIX).

Claim 65, drawn to methods for determining enhancers of LIPG-LDL, classified in class 435, subclass 4.

3. The inventions, Groups I-IX, are distinct, each from the other, because of the reasons stated previously in Paper No. 7 mailed April 24, 2001.

Notice of Possible Rejoinder

4. The Examiner notes that if product claims are found directed to an allowable product, then process claims, which are directed to processes of making or using the patentable product, respectively, previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also M.P.E.P. § 821.04, *In re Ochiai*, and *In re Brouwer*). Since process claims would be rejoined and fully examined for patentability under 37 C.F.R. § 1.104, Applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

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Election

5. A telephone call was made to Gene Yao on December 17, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

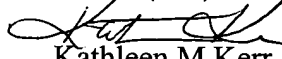
Conclusion

6. A complete reply to the instant Office action must include an election of invention, any one of Groups I-IX, to be examined.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Kathleen M Kerr
Examiner
Art Unit 1652

December 17, 2003